

## **REMARKS**

### **Claim Rejections**

Claims 1 and 2 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sutt, Jr. (U.S. 5,865,585) in view of Leistner (U.S. 5,482,419). Claims 3 and 4 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sutt, Jr. in view of Leistner and further in view of Rogers (U.S. 161,280).

### **Drawings**

Applicant proposed to amend Figure 1, as illustrated in red on the attached photocopy. In Figure 1 it is proposed to change reference number "111" to read --11--. No "new matter" has been added to the original disclosure by the proposed amendment to this figure. It is believed that the foregoing proposed amendment obviates the outstanding objections to the drawings. Approval of the proposed drawing change is respectfully requested.

It is noted that no Patent Drawing Review (Form PTO-948) was received with the outstanding Office Action. Thus, except for the above proposed drawing corrections, Applicant must assume that the drawings are acceptable as filed.

### **Amendments to Specification**

Applicant has amended the specification as noted above to cure obvious grammatical and idiomatic inaccuracies. It is believed that the foregoing amendments to the specification overcome the outstanding objections thereto. No "new matter" has been added to the original disclosure by the foregoing amendments to the specification.

### **New Claims**

By this Amendment, Applicant has canceled claims 1-4 and has added new claims 5-8 to this application. It is believed that the new claims specifically set forth each element of Applicant's invention in full compliance with 35 U.S.C. § 112, and define subject matter that is patentably distinguishable over the cited prior art, taken individually or in combination.

The new claims are directed toward a nail row comprising: a plurality of T-shaped nails (40), each of the plurality of T-shaped nails having: a nail shank (42); a nail head (41) connected to the nail shank and having a thickness from a front to a back that is larger than a thickness from a front to a back of the nail shank, the nail head having a flat striking surface (411) located on a top thereof, the nail head and the nail shank have co-planar left and right sides; two connecting portions (43), each of the two connecting portions being located one of the co-planar left and right sides and coated with an adhesive and adjoined to one of the two connecting portions of an adjacent one of the plurality of T-shaped nails; and two symmetrical oblique insert members (412), each of the two symmetrical oblique insert members are formed on a bottom of a protruding portion of the nail head and having: a horizontal plane (4121) spaced apart from and positioned parallel to the flat striking surface; and an inclined plane (4122) connected to the horizontal plane and having a nailing portion (413) formed by an acute angle formed between the inclined plane and one of the left and right sides of the nail head.

Other embodiments of the present invention include: each horizontal plane has a length that is twice a length of each inclined plane; the shank of each of the plurality of T-shaped nails has a plurality of oblique recessed lines (421) spaced apart an equal distance and located on the front and back thereof; and the top of the nail head of one of the plurality of T-shaped nails is located at a height different from a height of the top of the nail head of the adjacent one of the plurality of T-shaped nails, and each of the plurality of oblique recessed lines one of the plurality of T-shaped nails have an end aligning with an end of each of the plurality of oblique recessed lines of the adjacent one of the plurality of T-shaped nails.

The primary reference to Sutt, Jr. teaches an angled chisel point brad including a head (70) having a top surface (71), and a shank (60) having a point (80).

Sutt, Jr. does not teach each of the two connecting portions being coated with an adhesive and adjoined to one of the two connecting portions of an adjacent one of the plurality of T-shaped nails; each of the two symmetrical oblique insert members having an inclined plane connected to the horizontal plane; an inclined plane having a nailing portion formed by an acute angle formed between the inclined

plane and one of the left and right sides of the nail shank; nor does Sutt, Jr. teach each horizontal plane has a length that is twice a length of each inclined plane.

The secondary reference to Leistner teaches a nail with an offset reinforced head including a shank (14) connected to an offset nail head (16). The shank includes wires (18) welded thereto. Ridge members (22, 24) are connected between the shank and the nail head.

Leistner does not teach a nail head connected to the nail shank and having a thickness from a front to a back that is larger than a thickness from a front to a back of the nail shank; each of the two connecting portions being located one of the co-planar left and right sides; each of the two connecting portions being coated with an adhesive and adjoined to one of the two connecting portions of an adjacent one of the plurality of T-shaped nails; each of the two symmetrical oblique insert members having an inclined plane connected to the horizontal plane; an inclined plane having a nailing portion formed by an acute angle formed between the inclined plane and one of the left and right sides of the nail shank; nor does Leistner teach each horizontal plane has a length that is twice a length of each inclined plane.

The secondary reference to Rogers teaches a nail blank including T-shaped notches (E, H).

Rogers does not teach a nail head connected to the nail shank and having a thickness from a front to a back that is larger than a thickness from a front to a back of the nail shank; each of the two connecting portions being located one of the co-planar left and right sides; each of the two connecting portions being coated with an adhesive and adjoined to one of the two connecting portions of an adjacent one of the plurality of T-shaped nails; two symmetrical oblique insert members; each of the two symmetrical oblique insert members are formed on a bottom of a protruding portion of the nail head; each of the two symmetrical oblique insert members having a horizontal plane spaced apart from and positioned parallel to the flat striking surface; each of the two symmetrical oblique insert members having an inclined plane connected to the horizontal plane; an inclined plane having a nailing portion formed by an acute angle formed between the inclined plane and one of the left and right sides of the nail shank; nor does Rogers teach each horizontal plane has a length that is twice a length of each inclined plane.

Even if the teachings of Sutt, Jr., Leistner, and Rogers were combined, as suggested by the Examiner, the resultant combination does not suggest: each of the two connecting portions being coated with an adhesive and adjoined to one of the two connecting portions of an adjacent one of the plurality of T-shaped nails; each of the two symmetrical oblique insert members having an inclined plane connected to the horizontal plane; an inclined plane having a nailing portion formed by an acute angle formed between the inclined plane and one of the left and right sides of the nail shank; nor does the combination suggest each horizontal plane has a length that is twice a length of each inclined plane.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be

non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

Applicant submits that there is not the slightest suggestion in either Sutt, Jr., Leistner, or Rogers that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Neither Sutt, Jr., Leistner, nor Rogers disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicant's claimed structure. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious Applicant's new claims.


**Summary**

In view of the foregoing amendments and remarks, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

Date: January 12, 2005

By:

  
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Application No. 10/762,261

**IN THE DRAWINGS:**

Please amend Figure 1 as illustrated in red on the attached photocopy.